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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,707	07/12/2001	Jeff N. Maggioncalda	02821.P001XC	4572

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PATENT GROUP
FAEGRE & BENSON LLP
3200 WELLS FARGO CENTER
1700 LINCOLN STREET
DENVER, CO 80203-4532

EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/904,707

Applicant(s)

MAGGIONCALDA ET AL.

Examiner

Thomas A. Dixon

Art Unit

3629

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 18-78 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-13, 28, 29 and 43-77 is/are allowed.
- 6) ☒ Claim(s) 1-10, 18-27, 30, 31, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 32, 33, 36-42 and 78 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendments / Arguments

1. The terminal disclaimer submitted 09/22/03 is acceptable.
2. Examiner apologizes for the introduction of new objections/rejections after indication of allowable claims, but a final careful reading of the claims and review of the application before allowance revealed the following unresolved issues.
3. As evidenced by the objections, rejections and reasons for allowance below, examiner's assertion of multiplicity was proper, and that multiple inventions are clearly present in the claims, as asserted by examiner in the restriction requirement.
4. The term "and" was incorrectly construed in actions following the first office action, in that, when reading the claims that had a list containing more than one input item and the word "and" to incorrectly ascribe the meaning "and" to the word "and" and not "or" as is indicated by applicant's use of the phrase "one or more" as seen, for example, in Claim 1.

Therefore, limitations such as the "target level of investment risk ...investment" have been given no weight because the "one or more of "target retirement age or ...goal" is disclosed by Edesses.

5. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

Art Unit: 3629

a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 30, including a processor, a memory and a display are disclosed in Edesess as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim Objections

6. Claim 25 is objected to because of the following informalities, because of the use of the phrase “one or more” in the parent claim this limitation, though not disclosed by the prior art, can not be indicated allowable, because carries no patentable weight.

7. Claim 32 is objected to under 37 CFR 1.75 as being a substantial duplicate of claims 2. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

8. Claim 78 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 70. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Specification

9. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Art Unit: 3629

Double Patenting

10. Applicant is advised that should claims 1, 3 be found allowable, claims 23, 24 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 3-10, 18-27, 30-31, 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Edesess (5,884,287).

As per Claim 1, 20, 23.

Edesess ('287) discloses:

displaying a set of one or more input objects, the input objects to receive one or more input decisions including an indication of a target retirement age or an indication of a target level of investment risk or an indication of retirement income goal, see figure 4 (target \$1,750,000 at age 65) and column 4, lines 45-55;

displaying a set of one or more output values, the set of output values including an indication of the probability of achieving the retirement income goal and an indication of the most likely retirement income in current dollars based upon one or more input decisions and a recommended set of financial products, see figure 4 (Likelihood (%));

receiving an updated input decision via one or more of the input objects, see column 4, line 61 – column 5, line 4;

determining one or more new output values to reflect the one or more new output values, see column 5, line 23 – column 6, line 32;

refreshing the set of one or more output values to reflect the one or more new output values, see column 6, lines 28-65.

As per Claim 3, 24.

Art Unit: 3629

Edesess ('287) further discloses the target retirement is constrained to be feasible, see column 5, lines 1-4 and figure 3A (106).

As per Claim 4, 21.

Edesess ('287) further discloses displaying the recommended set of financial products, the recommended set of financial products conditional on the one or more input decisions, see column 2, lines 35-40.

As per Claim 5.

Edesess ('287) further discloses displaying a recommended allocation of wealth among those of the financial products in the recommended set of financial products, see column 2, lines 35-40.

As per Claim 6, 22.

Edesess ('287) further discloses the recommended allocation of wealth is conveyed graphically, see figure 4 (Recommended Asset Allocation).

As per Claim 7.

Edesess ('287) discloses:

- a) receiving a retirement income goal from the user, see column 4, lines 45-55;
- b) receiving one or more input decisions from the user, including an indication of a target retirement age and an indication of a target level of investment risk, upon which a probability distribution is dependent, the probability distribution representing a set of possible future portfolio values based upon the one or more input decisions, see column 2, lines 18-22, column 4, lines 45-55 and figure 4 (target \$1,750,000 at age 65);
- c) determining a probability of achieving the retirement income goal, see column 4, lines 56-60; and
- d) displaying the probability of achieving the retirement income goal to the user, see figure 4 (Likelihood(%)).

As per Claim 8.

Edesess ('287) further discloses a graphical input mechanism, see column 4, lines 26-37 and risk as an input to the determination of the efficient frontier, see column 2, lines 18-22.

As per Claim 9.

Edesess ('287) further discloses displaying the recommended set of financial products and a recommended allocation of wealth among the financial products in the set of recommended financial products, see column 2, lines 35-40.

As per Claim 10.

Art Unit: 3629

Edesess ('287) further discloses displaying the probability of achieving the income goal graphically, see figure 4 (Likelihood(%)).

As per Claim 18, 26.

Edesess ('287) discloses:

displaying one or more objects in a first portion of a first screen, the input objects configured to receive one or more input decisions including a financial goal, from which a recommendation is determined, the recommendation including a recommended allocation of wealth among a set of available financial products, see figure 4 (pie chart) and column 6, lines 28-65;

displaying a set of output values in a second portion of the first screen, the set of output including a probability of achieving the financial goal based upon the recommendation, see figure 4, (Likelihood(%)); and

graphically depicting the recommended allocation of wealth among the set of available products in a second screen, see figure 4 (Recommended Asset Allocation) and column 6, lines 28-65.

As per Claim 19, 27.

Edesess ('287) further discloses one or more input decisions include an indication of a target retirement age, see figure 4 (at age 65).

As per Claim 25.

Edesess ('287) further discloses a graphical input mechanism, see column 4, lines 26-37, but does not disclose receipt of a target level of risk, but as explained in the objection above, it carries no patentable weight.

As per Claim 30, 31.

Edesess ('287) discloses a processor, a memory and a display, see column 4, lines 9-21.

The non-structural limitations not disclosed by Edesess are seen to be non-functional descriptive material and intended use and will be given no patentable weight.

As per Claim 34.

Edesess ('287) discloses:

receiving an indication of a retirement income goal for a particular investor, see column 4, lines 22-38;

displaying a set of one or more input objects, the input objects to receive one or more input decisions including an indication of a target retirement age or an indication of a target level of investment risk or an indication of retirement income goal, see figure 4 (target \$1,750,000 at age 65) and column 4, lines 45-55;

displaying a set of one or more output values, the set of output values including an indication of the probability of achieving the retirement income goal and an indication of the most likely retirement income in current dollars based upon one or more input decisions and a recommended set of financial products, see figure 4 (Likelihood (%)).

Art Unit: 3629

As per Claim 35.

Edesess ('287) further discloses:

displaying a representation of the recommended allocation of wealth by graphically depicting relative allocations of wealth among those of the financial products of the set of financial products in the recommended portfolio, see figure 4 (pie chart).

Allowable Subject Matter

13. Claims 2, 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 11-13, 28-29, 43-77 are allowable.

15. The following is an examiner's statement of reasons for allowance:

As per Claim 2.

Edesess (5,884,287) in view of Baird (5,220,500) does not disclose or fairly teach:

a subset of the one or more input objects and a subset of the one or more output values are displayed concurrently on the same screen.

As per Claim 11.

Edesess (5,884,287) in view of Baird (5,220,500) does not disclose or fairly teach:

concurrently displaying input objects in a first portion of a screen, the input objects configured to receive one or more input decisions including level of risk, and a set of one or more output values in a second portion of the screen, the set of output value including the short-term risk associated with reach a financial goal.

As per Claim 28, 52.

Edesess (5,884,287) in view of Baird (5,220,500) does not disclose or fairly teach:

a step of displaying one or more input objects in a first portion of a first screen and displaying one or more output values in a second portion of the first screen.

As per Claim 36.

Edesess (5,884,287) in view of Baird (5,220,500) does not disclose or fairly teach:

Art Unit: 3629

identifying a relationship between future returns of each financial product of the set of financial products and future returns of combinations of one or more factor asset classes of a set of factor asset classes by determining each financial product's effective asset mix with respect to the set of factor asset classes.

As per Claim 43.

Edesess (5,884,287) in view of Baird (5,220,500) does not disclose or fairly teach:

receiving an indication of a financial goal of a particular investor;
receiving one or more input decisions that relate to tradeoffs in connection with pursuing the financial goal, the input decisions comprising an indication of a time horizon that is acceptable to the particular investor, an indication of a level of investment risk that is acceptable to the particular and that is constrained to be within a feasible set of risk that is attainable by a particular investor via a set of financial products that are available to the particular investor for investment and an indication of a level of savings that is acceptable to the particular investor.

As per Claim 61.

Edesess (5,884,287) in view of Baird (5,220,500) does not disclose or fairly teach:

determining a recommended allocation of wealth among a set of financial products that are available for investment by a particular investor, the set of financial products comprising one or more mutual funds, said determining based upon (a) a financial goal identified by the particular investor, and (b) input decisions relating to variables involved in pursuing the financial goal, the input decisions comprising an indication of a time horizon that is acceptable to the particular investor, an indication of a level of investment risk that is acceptable to the particular investor, and an indication of a level of savings that is acceptable to the particular investor.

As per Claim 70.

Edesess (5,884,287) in view of Baird (5,220,500) does not disclose or fairly teach:

identifying a relationship between future returns for each financial product of a set of financial products and future returns of combinations of one or more factor asset classes of a set of factor asset classes by determining each financial product's effective asset mix with respect o the set of asset classes;

receiving an indication of financial goal of a particular investor and an indication of time horizon, a level of risk and an indication of a level of savings that is acceptable to the particular investor.

The claims that depend from the above allowed claims are also allowable.

Art Unit: 3629

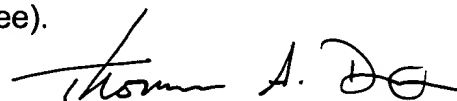
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Examiner
Art Unit 3629

April 9, 2004